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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,340	01/18/2002	Lou Chauvin	83304EF-P	9965

7590 03/17/2009  
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EXAMINER
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CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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2452

MAIL DATE	DELIVERY MODE
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03/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/051,340	<b>Applicant(s)</b> CHAUVIN ET AL.	
	<b>Examiner</b> DOHM CHANKONG	<b>Art Unit</b> 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-29, 31, 32 and 34-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-29, 31, 32, and 34-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is in response to Applicant's request for continued examination. Claims 23, 29, 34, 37, 38, and 40 are amended. Claims 1-22, 24, 30-33, 35, 36, and 42-44 had been previously cancelled. Accordingly, claims 23-29, 31, 32, and 34-43 are presented for further examination.

2. This action is a non-final rejection.

### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/17/2009 has been entered.

### ***Response to Arguments***

4. Applicant's amendment to the independent claims do not overcome the cited Reifel reference. Applicant argues that Reifel only discloses an home PC order terminal that is owned and controlled by the user and does not disclose an order terminal that is controlled by a business entity. Applicant's argument is not persuasive because Applicant's specification contradicts Applicant's argument that a user terminal such as a home PC cannot be interpreted as the claimed order terminal. Applicant's specification states: " business entities (such as retail

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store owners and device or software suppliers) who control various types of order terminals, (such as photo kiosks, portable digital imaging devices, *or home PCs running application software*)" (emphasis added) [USP 20030038882, para. 8]. In describing the application software running on the home PC, Applicant's specification further discloses that "a customer at block 48 may run a software application via a conventional web browser such as Netscape Navigator for gaining entry to system 10" [2003003882, para. 40]. Thus, according to Applicant's specification, a business entity may control a home PC (owned by a user) when the home PC runs a software application via a browser to access the photo services.

Similarly, Reifel discloses a home PC running a software application through a web browser that accesses a website that is run by a business entity [column 15 «lines 36-44»: Reifel's order taker corresponds to business entity | column 16 «lines 19-24»]. Thus, based on Applicant's specification describing what is meant by a business entity controlling a terminal, Reifel's home PC reads on the claimed order terminal. Moreover, like Applicant, Reifel discloses another embodiments of an "order terminal" in the form of a kiosk that may be controlled by a business entity [Fig. 13 «item 20» | column 19 «lines 18-26 and 61-65: kiosk operator]. Reifel's kiosk also reads on Applicant's claimed order terminal that is controlled by a business entity.

For the foregoing reasons, Applicant's amendment does not over the Reifel reference. The rejection set forth in the previous action are therefore maintained.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 23-29, 31, 32, and 34-43 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7,075,244.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they only contain minor differences in the claim language. Taking claim 1 as the exemplary claim from the instant application and the ‘244 patent, both claims are directed to a method for providing photo services to a user. Both claims disclose maintaining business relationship data between service providers and business entities and providing specific services based on this maintained relationship data.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23, 34, and 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the independent claims to recite that the portable digital storage device is provided by the service provider. However, this feature is not described or disclosed in Applicant's specification. Instead, the specification describes that the storage devices are provided by digital storage device providers or business entities which are not the same thing as service providers. According to the specification, service providers provide photo services and there is no description of the service provider providing the digital storage device to the user.

Moreover, Applicant's specification and claim language actually contradicts the new claim limitation. The specification recites "the camera or memory card can be programmed with an identifying code indicating which business entity (e.g. which retailer or manufacturer) sold the product" [20030038882, para. 0089]. Claims 23, 34, and 44 recite that "said one of the plurality of service providers identified by electronically reading a code stored on the portable digital storage device." Thus, it is the *business entity*, and not the service provider, that provides the digital storage device to the user. Appropriate correction of the claims to insure the claim language is commensurate with the specification is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 23-27, 29, 31, 32, 34-37, and 39-44 are rejected under 35 U.S.C §103(a) as being unpatentable over Reifel et al, U.S Patent No. 7.013.288 [“Reifel”] in view of Mizumo, U.S. Patent Publication No. 2001|0021311.

7. As to claims 23, 34 and 44, Reifel discloses a method comprising:  
providing a network service on a network [Figure 1];  
allowing a user to access a network server via the network service for ordering products using a network connected order terminal [Figure 1 | Figure 3 «item 308» | Figure 13 «items 20, 25»]; said order terminal controlled by a business entity [see Response to arguments above | Fig. 13 «items 20, 25»];

in response to a user coupling a portable digital storage device to a network connected order terminal [column 3 «lines 35-39»], electronically reading the portable digital device, the portable digital storage device provided by one of a plurality of service providers and having an image stored thereon [column 3 «line 53» to column 4 «line 4» | column 19 «lines 18-26 and 61-65: kiosk controlled by a service provider providing the storage device], said one of the plurality of service providers identified by electronically reading a code stored on the portable digital

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storage device [column 12 «lines 29-38» | column 13 «lines 10-14» : camera-related information stored on the camera], the plurality of service providers each having a predefined business relationship with said business entity [column 5 «lines 28-44» | column 12 «line 6»];

maintaining relationship data indicating a rating of the predefined business relationships in a database coupled to the communication network [column 5 «lines 28-44» | column 12 «line 6» : camera provider can restrict the vendors from which the consumer can receive services or the consumer can pay a higher fee to use those vendors not associated with the manufacturer]; and

displaying to the user an order screen on said order terminal in response to reading the code stored on the portable digital storage device, the order screen including primary purchasing information provided by at least two of said plurality of service providers from which the user can order a product and/or service related to the image stored on the portable digital storage device, the primary purchasing information being modified in response to a rating of a predefined business relationship between said business entity and said at least two of the plurality of service providers [column 5 «lines 11-19 and 28-44» | column 12 «line 6» : Reifel discloses that a user may elect, by activating links to print houses or vendors that are approved by the camera provider or decide to use a lower rated vendor and pay a fee].

While Reifel discloses at least two service providers (print houses), one of which has a higher rating than the other [column 5 «lines 28-44» : a service provider that is preferred by the manufacturer of the device has a "higher" rating than a service provider that is not preferred], Reifel does not expressly disclose modifying an order screen such that the higher rated service



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provider is displayed first. However, this feature was well known in the art at the time of Applicant's invention as taught by Mizumo.

Like Reifel, Mizumo is directed towards a network photo-print service. Mizumo discloses an order screen whereby a user may select from a plurality of service provider [Figure 10 «item P5»]. Mizumo discloses that the order in which the providers are displayed based on certain conditions for the delivery site [0120, 0124]. While Mizumo does not disclose displaying a higher rated provider first, one of ordinary skill in the art would have applied Mizumo's ordering features to Reifel's teachings. As noted above, Reifel discloses two service providers that have different relationships to a business entity. It would have been obvious for one of ordinary skill in the art, in reading Mizumo, to have organized the order screen such that the preferred service provider (the provider in which the manufacturer has a relationship) is listed prior to the business entity with whom the manufacturer does not have relationship [column 5 «lines 41-45»]. One would have been motivated to provide such a modification to Reifel's photo service because displaying preferred providers first increases the possibility that the customer will see the better prices for printing the photographs.

8. As to claims 24, 35 and 42, Reifel discloses:

reading a second portable digital storage device having a second image stored thereon coupled to the network connected order terminal by the user, the second portable digital storage device associated with a second one of the plurality of service providers [column 3 «lines 65-67» : camera providers];

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displaying to the user an order screen on said order terminal including second purchasing information for ordering said same product and/or service but for the image stored on the second portable digital storage device, the second purchasing information including a higher price for said product and/or service in response to a lower rating of a predefined business relationship between said second one of the storage providers and one of the business entities [column 5 «lines 29-44» : the discounts for prints based on the providers relationship with the print house].

9. As to claims 25 and 37, Reifel discloses modifying the primary purchasing information to include a lower purchase price from service providers in response to better ratings of business relationships [column 5 «lines 28-44» | column 12 «line 6» : consumers receive cheaper prints at approved print houses or vendors].

10. As to claims 26 and 39, Reifel discloses said order terminal comprising one of the following, an automated teller machine, a kiosk, a personal computer, or a wireless device [Figure 13 «item 20»].

11. As to claims 27 and 41, Reifel discloses said portable digital storage device comprising one of the following: optical disc, magnetic floppy disk; flash memory device, or a digital camera [Figure 13 «items 5, 20»].

12. As to claims 29 and 40, Reifel discloses said one of a plurality of service providers provides one or more of the following: local printing of digital images, remote printing of digital

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images, on-line storage of digital images, providing digital storage media containing digital images, and providing associated goods and/or services with respect to hard copy prints [column 5 «lines 28-44»].

13. . As to claim 31, Reifel discloses a potential rating of said predefined business relationships include at least two levels [column 5 «lines 28-44» : restricted vs. non-restricted print houses].

14. As to claim 32, Reifel discloses the step of maintaining relationship data is performed by a service manager using a table in a database of the server [Figure 13 «item 13»].

15. As to claims 36 and 43, Reifel discloses excluding merchants based on ratings of the business relationships between the service providers and the excluded merchants [column 1 «lines 61-66» : unauthorized print houses read on excluded merchants].

16. Claims 28 and 38 are rejected as being unpatentable over Reifel, in view of Vittal et al, U.S Patent No. 6.907.401 [“Vittal”].

17. As to claims 28 and 38, Reifel does not expressly disclose displaying different types of products and/or service on the order screen for the user to select, wherein some of the products and/or services are displayed more prominently based on said rating of a predefined business relationship between said one of the plurality of service providers and the merchant. However,

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Vittal discloses that such a feature was well known at the time of Applicant's invention. Vittal specifically discloses modifying purchasing information based on relationships between the merchant and a service provider such that the merchant's product is displayed (advertised) more prominently [column 1 «lines 55-64» where : being advertised more prominently implies that that they are "displayed first"]. It would have been obvious to one of ordinary skill in the art to modify Reifel to include Vittal's teachings of prominently displaying provider products on a merchant's site based on a contract between the merchant and the service provider. One would have been motivated to modify Reifel as such functionality improves upon Reifel's merchant-service provider system by increasing the number of options in the merchant-provider contract.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/  
Examiner, Art Unit 2452